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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Wolfgang Hirschburger

Serial No.: 10/757,660

Conf. No.: 4465

Filed: 1/14/2004

For: NOSE TIP CONTROL FOR
CORDLESS HIGH SPEED ROTARY
TOOL

Art Unit: 3722

Examiner: Gates, Eric Andrew

**APPELLANT'S REPLY BRIEF
PURSUANT TO 37 CFR § 41.41**

This Reply Brief is in response to the Examiner's Answer mail dated January 13, 2009.

The Crutchfield Patent has a Switch Assembly That Includes a Small Switch Button Device 30

Appellants contend, in their main brief and here, that Crutchfield fails to anticipate, teach or suggest this claim because it fails to include, *inter alia*, a light touch switch having at least a first position and a second position coupled to said electrical control circuit for selectively enabling or disabling said control circuit to turn the motor on and off **wherein the motor current does not flow through said switch**. The crucial issue in this appeal revolves around the meaning of the word **switch**.

Crutchfield's specification introduces the **switch assembly 28** in the sentence "... when the DC motor 26 is activated by switch assembly 28 when placed in the 'on' position by depressing switch button device 30 down with respect to first opening 32 formed in the wall of front portion 14 and surrounding switch button device 30." (Col. 3, lines 44-48) The switch assembly is further defined in the specification "... **switch assembly 28 comprises front mounting assembly 62, microswitch device 78, switch button device 30 and spring device 82.**" (Col 4, lines 45-49).

Crutchfield has always had only one actual switch device and that is the microswitch device 78. At paragraph 4, lines 55-58, in connection with Fig. 4b, it describes a "switch button device 30 comprises a ring-like portion 86 and a lever portion 88 which is cantilevered from said ring-like portion 86 at approximately 85°." **The switch button device 30 is not a switch**. It is just a mechanical linkage. The actual switch of Crutchfield is the microswitch device 78 which necessarily has the switch contacts in it and **it is indisputable that the microswitch device 78 does have motor current flowing through it**. Therefore, Crutchfield fails to anticipate, teach or suggest claim 1.

The Meaning of “Switch” Should not be Determined by Extrinsic Evidence

The Examiner asserts that a dictionary definition should control the meaning of “switch” and that by using such a definition the switch button device 30 is a switch.

The Court of Appeals for the Federal Circuit has rendered many opinions that have decided the meaning of words in a claim and the process in which it should be done. Those opinions are very relevant in this appeal. In the case of *Byrne v. Black & Decker Corp.* 235 Fed.Appx. 741, 745, 2007 WL 1492101, 3 (Fed.Cir.2007), the Court stated: When a claim is construed, claim terms should generally be given their “ordinary and customary meaning.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-14 (Fed.Cir.2005). **The meaning of a claim is determined by using intrinsic evidence, which includes the claims, the specification, and the prosecution history and by using extrinsic evidence, which includes dictionaries. *Id.* at 1319. However, extrinsic evidence in determining the meaning of a claim may be less reliable than intrinsic evidence: “extrinsic evidence may be useful to the court, but it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of intrinsic evidence.” *Id.* This court has cautioned that “heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification.” *Id.* at 1321. (emphasis added)**

In *Novartis Pharmaceuticals Corp. v. Eon Labs Mfg., Inc.* 363 F.3d 1306, 1310 (Fed.Cir.2004) the following is stated: (“**Because words often have multiple dictionary definitions, some having no relation to the claimed invention, the intrinsic record must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor.**”); *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed.Cir.1998) (“**[W]here there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meaning.**”) (emphasis added).

In *W.E. Hall Co., Inc. v. Atlanta Corrugating, LLC* 370 F.3d 1343, 1350 (Fed.Cir.2004), the Court stated: when construing claims, “the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history.” *Vitronics*, 90 F.3d at 1582. We indulge a “heavy presumption” that the claim terms carry their ordinary and customary meaning. *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed.Cir.1999). The ordinary and customary meaning of a claim term to one of ordinary skill in the art may be ascertained from a variety of sources, first, as *Vitronics* instructs, from the intrinsic evidence of record such as the claims themselves, the written description, and the prosecution history, but also from the “common understanding” of the terms that may be reflected in dictionaries, encyclopedias, and treatises. 90 F.3d at 1582; *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1203 (Fed.Cir.2002); *Ferguson Beauregard v. Mega Sys., LLC*, 350 F.3d 1327, 1338 (Fed.Cir.2003). **While dictionaries may be used to ascertain the plain and ordinary meaning of claim terms, the intrinsic record is used to resolve ambiguity in claim language or, where it is clear, trump inconsistent dictionary definitions.** *Kumar v. Ovonic Battery Co., Inc.*, 351 F.3d 1364, 1367-68 (Fed.Cir.2003) (quoting *Tex. Digital Sys.*, 308 F.3d at 1204 (Fed.Cir.2002)) (emphasis added).

Because the Appellants’ specification provides an extensive and clear description of the invention, there is no ambiguity in the meaning of the word “switch” in the claims of this application. The Examiner even admits that “Appellant’s specification does clearly state that the term ‘switch’ means a device that must include electrical as well as mechanical elements.”

Because of the lack of ambiguity and the common understanding of the term is clear, the use of extrinsic evidence such as the Examiner’s convenient choice of definition should not trump the intrinsic evidence provided by the Appellants’ specification.

**Even if the Examiner's Dictionary Definition Controls, the
Switch Button Device 30 is not part of an Electric Circuit**

The Examiner asserts that a dictionary definition should control the meaning of "switch", and applies Webster's Online Dictionary definition of "switch", definition 5, which states that a switch is a "a device for making, breaking or changing the connections in an electrical circuit." The Examiner further states "Appellants state that a switch button device 30 is just a mechanical linkage, and do not state how the claim language does not allow for this interpretation." The Examiner does admit that "the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification" and further admits in the next sentence that "Appellant's specification does clearly state that the term 'switch' means a device that must include electrical as well as mechanical elements."

The Examiner's own chosen definition for "switch", which is definition 5, (why not definitions 1-4?), defines it as "**a device for changing the connections in an electrical circuit.**" The Examiner's own choice is telling, however, because the single Wikipedia definition of an electrical circuit is as follows:

An **electrical network** is an interconnection of electrical elements such as resistors, inductors, capacitors, transmission lines, voltage sources, current sources, and switches.

An **electrical circuit** is a network that has a closed loop, giving a return path for the current. A network is a connection of two or more components, and may not necessarily be a circuit.

This definition of an electrical circuit clearly demonstrates that a switch button device 30 is not a switch, inasmuch as it is not part of an electric circuit. It is at most a mechanical linkage to the real switch, which is clearly described as the microswitch device 78.

For the above reasons, Crutchfield fails to anticipate, teach or suggest the claims on appeal and Applicant requests the rejections be reversed.

Respectfully submitted,

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